

REMARKS

Claims 1-19 are pending in this application. By this Amendment, the specification and claims 1-16 are amended, and claims 18 and 19 are added. Support for the amendments to the claims and new claims may be found, for example, in the specification at page 4, lines 18-19; page 4, lines 21-22; page 5, lines 18-19; and in the claims as originally filed. No new matter is added.

I. Restriction and Election of Species Requirement

In reply to the Restriction and Election of Species Requirement, Applicant provisionally elects Group I, claims 1-14 and 17, with traverse. Applicant respectfully submits that that new claims 18 and 19 should be included within Group I. As a species, Applicant provisionally elects bisphenol A diglycidyl ether as the epoxy resin, and m-cresol, diethylenetriamine (DETA) and 1,3-N,N-dimethylaminopropylamine as the reactants for the Mannich base, with traverse. Claims 1-14 and 17-19 read on the elected species. At least claims 1, 2, 4-6, 9-15 and 17 are generic.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. See MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.* Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims. See ISPE 10.06.

A priori unity of invention exists because all of the claims share a glass transition temperature of more than 80°C as a common technical feature. The Office Action appears to

acknowledge that *a priori* unity of invention exists and, thus, applies WO 00/01659 in asserting that *a posteriori* unity of invention does not exist. See page 5. However, WO 00/01659 does not disclose a glass transition temperature of more than 80°C. Accordingly, the Office Action has failed to establish *a posteriori* lack of unity of invention. Also, claims 15 and 17 depend from claim 1 and, thus, there is no need to determine whether unity of invention exists for purposes of a restriction requirement. Thus, the restriction requirement is improper, and its withdrawal is respectfully requested.

Moreover, restriction between different embodiments (species) of an invention encompassed by an independent claim is only proper under PCT Rule 13 if the claim recites distinct embodiments (such as a Markush group), and the Office Action establishes that the distinct embodiments share no common subject matter that defines a contribution over the prior art. *See* IPSE 10.09; MPEP §1850(II). Neither of these conditions have been met in this case. Accordingly, the election of species requirement is improper and must be withdrawn.

Alternatively, it is understood, that upon search, examination, and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims. Because generic claims 1, 2, 4-6, 9-15 and 17 are believed to be allowable, Applicant respectfully requests rejoinder and examination of the non-elected species.

It is also respectfully submitted that the subject matter of all claims and species is sufficiently related that a thorough search for the subject matter of any one Group of claims and species would encompass a search for the subject matter of the remaining claims and species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. *See* MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should

apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of this application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:TTK/emd

Attachment:
Petition for Extension of Time

Date: November 23, 2009

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